

REMARKS

The Official Action mailed January 24, 2002, has been carefully considered. Reconsideration and allowance of this application in light of the foregoing amendments and accompanying remarks is respectfully requested.

The original patent will be surrendered upon indication that the application is in condition for allowance.

THE OBJECTION TO THE DRAWINGS

In paragraph 2 of the Official Action, the Examiner has requested the filing of a corrected drawing sheet that is marked as "amended." Appended hereto is a corrected drawing sheet that is in compliance with 37 C.F.R. 1.173.

THE ALLOWED CLAIMS 1-26

The Examiner's indication, in paragraph 6 of the Official Action, that claims 1-26 are allowed, has been noted with appreciation.

STATEMENT OF STATUS OF ALL PATENT CLAIMS AND ALL ADDED CLAIMS

Pursuant to 37 C.F.R. §1.173(c), the following claims are pending: 1-36, 38-54, and 71-78.

Claims 37 and 55-70 have been cancelled in order to reduce the number of claims and thereby facilitate the prosecution of this application.

EXPLANATION OF CLAIM SUPPORT

Pursuant to 37 C.F.R. §1.173(c), the table presented in the STATUS OF CLAIMS AND EXPLANATION OF SUPPORT FOR CLAIM CHANGES document filed with the application, and the accompanying discussion therein, explains support for the claims. Support for added claims 75-76 may be found in column 7, lines 20-23 and in the drawings.

Claim 77 has the same support as patent claim 18. Claim 78 has the same support as patent claim 22.

THE REJECTIONS OF CLAIMS 27-74 UNDER 35 U.S.C. §251 ARE OVERCOME

In paragraph 3 of the Official Action, the Examiner has rejected claims 27-74 under 35 U.S.C. §251 "as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based." It is the Examiner's stated position that "the record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant surrendered during the prosecution of the application." In support of this position, the Examiner states that "each claim of patent 5,938,087 included the limitation of a pry-off lid that 'seals against an outside of said spout' (claims 1, 18 and 22), or is 'arranged to seal around an outside of said spout' (claims 13)." The Examiner further states (a) that "this limitation was not present in the originally filed claims", (b) that this limitation was added and argued "to overcome the Song et al. Reference which did not include a lid which sealed on the outside surface", and (c) that Applicant "specifically identified this limitation as not being present in the cited prior art and also identified this limitation as a primary reason for allowing all of the claims."

For reasons discussed below, particularly in view of the amendments to the claims presented herein, this basis of rejection is respectfully traversed.

The Examiner's attention is specifically invited in M.P.E.P. §1412.02 to the section entitled "REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME ASPECTS, BUT NARROWER IN OTHERS:" (page 1400-15 of the Original Eighth Edition, August, 2001). For reasons that will be herein discussed, this section of the M.P.E.P. is applicable to the present facts. This section provides clear guidance with respect to a factual situation that avoids the effect of the recapture rule. In particular, the recapture rule is avoided if the reissue claims are broader in certain aspects and narrower in OTHERS vis-a-vis claims cancelled from the original application to obtain a patent "if the claims are broader in a way

that does not attempt to reclaim what was surrendered earlier.” Mentor Corp. V. Coloplast, Inc. 998 F.2d 992,994, 27 USPQ 1521, 1525 (Fed. Cir. 1993). The Hester Industries, Inc. case, cited by the Examiner in the Official Action, references the Mentor Corp. case and states “[F]inally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects.” Also, the cited In re Clement case and the Ball Corp. case each recognize this basis of avoiding the “recapture rule.”

Turning to the facts of the present case, the Examiner has properly observed that the claims 1, 13, 18 and 22, of U.S. Patent No. 5,938,087, include a recitation to the effect that the seal is located against or around an outside surface of the spout and that this particular locational relationship of the seal is not recited in reissue application claims 27-74. However, the Examiner’s assertion that this limitation was a “primary reason for allowing all of the claims” of U.S. Patent No. 5,938,087 over Song and other prior art, is not supported by the Examiner’s statement of reasons for allowance in the Notice of Allowability document. This document sets forth numerous reasons for allowance, none of them relate to the lid sealing on the outside of the spout. Accordingly, it is most apparent that the Examiner did not deem the lid seal recitations to be one of the primary reasons for allowing the claims.

Claims 27-74 have been amended to further define the seal between the lid and the spout as including (a) a continuously curving first sealing surface on the spout, (b) a sealing element on the lid defining a second continuous curving sealing surface, and (c) a surface-to-surface contact between the first and second sealing surfaces when the lid is in its closed position. These specific recitations are not present in any of the claims in U.S. Patent No. 5,938,087. Accordingly, while claims 27-74 in certain respects define the seal between the lid and the spout more broadly (seal not being limited to a location against the outside of the spout), these claims also define this same seal more narrowly in a material respect (recitations a-c above).

EXCEPT

As set forth above, the "recapture rule" may be avoided in instances where the reissue claims are broader in certain respects and narrower in other respects. In view of the above discussion, it is respectfully submitted that amended claims 27-74 have been materially narrowed with respect to the limitation of the alleged recapture (the seal between the lid and the spout) so that the "recapture rule" is avoided. Accordingly, it is respectfully submitted that amended claims 27-74 are in compliance with 35 U.S.C. 251.

THE REJECTION OF CLAIM 71 UNDER 35 U.S.C. §102(b) IS OVERCOME

In paragraph 5 of the Official Action, claim 71 is rejected under 35 U.S.C. §102(b) as being anticipated by Vesborg. The Examiner states that "Vesborg discloses a dispensing structure including a body 51, a spout 60, a meniscus forming area 77, a conduit as is the inner wall of chamber 77, and a lid 15." The Examiner has further deemed that "it would have been obvious to one of ordinary skill in the art to make the bottle of Vesborg either bigger or smaller resulting in a conduit of 0.3 inches."

For reasons discussed below, it is respectfully submitted that claim 71, as amended, is patentable over Vesborg.

Vesborg discloses a closure device for closing an opening in a neck of a container containing a product releasing gases, for a controlled venting of the container. The closure includes a pouring member with a pouring opening that is sealingly fastened to the neck of the container. A cap is fastened to the pouring member. A venting means is provided between the cap and the pouring member to vent the container when the pressure difference between the interior of the container and the surroundings exceeds a specific value.

Claim 71, as amended, defines a dispensing structure that includes a body having a wall portion with a spout defining a dispensing orifice. The body includes a conduit having a passage in fluid communication with the orifice that extends from an inside surface of the wall portion in a direction away from the spout. The passage is free of obstructions. At least a portion of the spout has a continuously curving first sealing surface. The dispensing structure includes a pry-off lid that has a lid portion which seals against the spout when the

lid is mounted on the body. The lid has a sealing element that defines a continuous curving second sealing surface that seals in surface-to-surface contact against the spout first sealing surface to create a continuous seal between the lid sealing element, when the lid is in its closed position.

In contrast, the Vesborg closure does not include a conduit that extends from the inside surface of the wall portion in a direction away from the spout to define an obstruction free passage in fluid communication with the orifice of the spout, in the manner as recited in amended claim 71. Additionally, the Vesborg closure does not have a pry-off lid that has a sealing element that defines a sealing element having a continuously curving sealing surface that is arranged to seal in surface-to-surface contact against a continuously curving sealing surface associated with the spout, when the lid is in its closed position, in the manner is recited in amended claim 71.

In view thereof, it is respectfully submitted that amended claim 71 is patentable over Vesborg and the other prior art of record.

THE NEW CLAIMS 75, 76, 77, AND 78 ARE ALLOWABLE

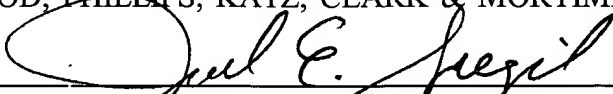
For many of the same reasons that claims 1-74 are in condition for allowance, it is respectfully submitted that new claims 75-78 are also in condition for allowance.

It is respectfully submitted that the application is now in condition for allowance.

Respectfully submitted,

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER

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